REMARKS/ARGUMENTS

The outstanding Office Action rejects claims 1-10 on various grounds over the U.S. Patents to *Meierhoefer* (USPN 3,494,458 hereinafter "*Meierhoefer*") and *Thomas et al.* (USPN 4,337,858 hereinafter "*Thomas*"). Claims 1 and 5 are amended to further clarify certain subject matter regarded as the invention. Claims 1-10 are pending in this application.

Initial Comments

Claim 1 has been amended to correct a grammatical error and Claim 5 has been amended to comply with an Examiner request.

Rejections Under 35 U.S.C. § 112

Claims 1-9 have been rejected under 35 U.S.C. § 112, 2nd paragraph as being indefinite for including language referring to the "contact lens". The idea here is to claim a container not the lenses. In accordance with the guidance of the Examiner, this feature is now stated on the record. Additionally, Claim 5 is amended to comply with the kind request of the Examiner and it now states "**a** contact lens" rather than --**the** contact lens--. Accordingly, it is now respectfully submitted that the rejected claims are now in condition for allowance. Therefore, applicants respectfully request that this ground of rejection be withdrawn and that these claims be withdrawn.

Rejections Under 35 U.S.C. § 103

Claims 1-9 and alternatively Claims 1-10 have been rejected under 35 U. S. C. § 103(a) as being unpatentable over the combination of *Meierhoefer* (USPN 3,494,458 hereinafter "*Meierhoefer*") and *Thomas et al.* (USPN 4,337,858 hereinafter "*Thomas*").

The significant shortcomings of *Meierhoefer* were well explained in the last response to Office Action (Amendment B). In an effort to make up for the shortcomings of the cited art, *Thomas* has been added to the combination. The applicants respectfully point out that the combination of *Meierhoefer* and *Thomas* produces an inoperative device and thereby creates an impermissible combination due to the fact that the combination is now made unsuitable for its intended (or any purpose) purpose.

Claim 1 recites a "resealing prevention feature prevents each housing area from being resealed by the cover unit by ***irreversibly changing the configuration of the case main unit when the sealed state is lost***, wherein said irreversible change in the configuration of said case main unit is caused by the detachment of a portion of members comprising a part of said case main unit, said irreversible change comprising at least one of" (emphasis added). The *Thomas* screw top cover member 22 is screwed shut to secure the case in a closed configuration. Such a screw top requires a circular threaded base member 24. The applicants point out that once the cover 22 is screwed shut it is difficult to configure the lens case into something that is not reusable (i.e., the circular threaded lid and base are easily reusable in almost any configuration). This poses a problem when adapted to a one shot disposable container as claimed and taught in the invention. It is very difficult to configure the *Thomas* structure into something that is not reusable. If the *Thomas* case is to be combined with the wedge-shaped closures 24 of *Meierhoefer* then the basic structure of the lens case must be changed. The claimed invention is a lens case, *Meierhoefer* is not, nor is the structure *Meierhoefer* suitable to the snap top lens case taught in the present invention.

Putting aside the fact that the combined references do not teach or suggest the claimed invention, cited combination is deficient for at least one other reason. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant"s disclosure." *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The initial burden is on the examiner to provide some suggestion of the desirability of combining the references to do what the inventor has done. (Cf. *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). If, as in this case, the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the examiner to explain why the combination of the teachings is proper. *Ex parte Skinner*, 2 USPQ2d 1788 (Bd. Pat. App. & Inter. 1986). In the present case, the Office Action has not satisfactorily identified any motivation to combine the references and explained why such combination is proper.

The Office Action, as it sole rationale for combining the references, states "it would have been obvious to one of ordinary skill in the art" to combine the teachings of *Meierhoefer* and *Thomas*. This line of reasoning is expressly forbidden by the case law. "The level of skill in the art cannot be relied upon to provide the suggestion to combine references." *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999)(emphasis added). "A statement that modifications of the prior art to meet the claimed invention would have been " 'well within the ordinary skill of the art at the time the claimed invention was made' " because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references." *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993)(emphasis original). There is no suggestion in any of the cited references indicating that they should be combined.

The claimed invention has a unique configuration not suggested by the cited art. Moreover, the cited combination suggest a configuration which is not enabling of a one time use device as is claimed here. Accordingly, the device taught by the cited combination does not teach all of the claim limitations and would not be operable to function as the claimed device. Accordingly, the cited combination fails to establish a prima facie case of obviousness.

In view of the foregoing, when applied to the standard established in *In re Vaeck*, the cited references fail to establish a prima facie case of obviousness as to Claims 1-10. As explained above, there is no suggestion or motivation to modify the reference or to combine reference teachings. Additionally, for the reasons explained above, there is no reasonable expectation of success as the device would not be operative as explained above. Finally, it is not clear that the prior art references teach or suggest all the claim limitations.

Conclusion:

In view of the foregoing amendments and remarks, it is respectfully submitted that the claimed invention as presently presented is patentable over the art of record and that this case is now in condition for allowance.

Accordingly, the applicants request withdrawal of all pending rejections and request reconsideration of the pending application and prompt passage to issuance. As an aside, the applicants clarify that any lack of response to any of the issues raised by the Examiner is not an

admission by the applicant as to the accuracy of the Examiner's assertions with respect to such issues. Accordingly, applicant's specifically reserve the right to respond to such issues at a later time during the prosecution of the present application, should such a need arise.

As always, the Examiner is cordially invited to telephone the applicants representative to discuss any matters pertaining to this case. Should the Examiner wish to contact the undersigned for any reason, the telephone numbers set out below can be used.

Additionally, if any fees are due in connection with the filing of this Amendment, the Commissioner is authorized to deduct such fees from the undersigned's Deposit Account No. 50-0388 (Order No. MES1P083).

Respectfully submitted,

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